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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,528	07/27/2001	Pito Salas	ITI-002CN	3156

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EXAMINER
SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/916,528	SALAS ET AL.
	Examiner	Art Unit	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 October 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-57</u> is/are pending in the application.

    4a) Of the above claim(s) <u>5,8,12 and 15-57</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-4,6-7,9-11,13-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 75

DETAILED ACTION

1.   This communication is in response to applicant's amendment filed October 3,

2005. Claims 5, 8, 12, and 15-57 have been canceled. Claim 1 has been amended.

Claims 1-4, 6, 7, 9-11, 13 and 14 are currently pending in this case.

Response to Arguments

2.   Applicant's arguments, see Amendment After Nonfinal, filed October 3, 2005,

with respect to Section 101 rejections of claim 1 have been fully considered in light of

the amended version of this claim and are persuasive. The section 101 rejection of

claim 1 has been withdrawn.

3.   Applicant's arguments, see Amendment After Nonfinal, filed October 3, 2005,

with respect to the Terminal Disclaimer have been fully considered in light of the

amended Terminal Disclaimer and Power of Attorney filed October 3, 2005 and are

persuasive. The examiner's objection to the Terminal Disclaimer has been withdrawn,

as well as the double-patenting rejections to claims 1-4, 6, 7, 9-11, 13, and 14.

4.   With respect to the section 103 rejection of claims 1-4, 6, 7, 9-11, 13, and 14,

Applicant's arguments filed October 3, 2005 have been fully considered but they are not

persuasive. Applicant argues that the cited references do not disclose a license string

being generated using a cryptographic process by encoding data that includes,

specifically "date" information corresponding to at least of: a date of creation of the

product; a date of request for the product; and a dater of generation of the license

string; and verifying the license string including by: decoding the license string to identify

the information; and determining that the "date" information is within a valid range, as recited in claim 1.

5.   Attention is directed to Barber et al (US 5,390,297) at, e.g. col 10, lines 1-27: ". . . the license manager 25A then determines whether the current date is later than the expiration date of the inactive license 27 (see FIG. 2B). If so, then the license 27 has "expired" and the license manager 25A takes the path 33 and returns to the next step 34. If not expired, the license manager 25A then takes a path 35 indicating that the license 27 is inactive, current and valid. The path 35 leads to step 36 that now marks such license 27 as being "active" or "in use" in response to the new request to use the computer program 24A (see item 2 in file 22A, FIG. 2B). This prevents the inactive, current, valid license 27 from being assigned to any other node 12. The license manager 25A then takes a path 37 to a step 38 that returns a status to the computer program 24A indicating that it is authorized to run, which enables the computer program 24A to run on the CPU 18 at the local node 14." Obviously, in determining by date whether the license is valid, the date of creation of the license, length of license validity and expiration date of license are determined and thus a range of dates is determined. Further, it would be obvious to also such data as dates of requesting the product and date of creation of product as alternate license information for cryptographic purposes.

6.   Attention is further directed to Griswold (US 5,390,297), disclosing a licensing management system and further teach sending datagrams to a licensor's site to request authorization for access to a product wherein the datagram includes encrypted information corresponding to a version of the product such as a product model number

(Figures 2 and 4; Col. 5, lines 45-50; Col. 6, lines 44-48; Col. 7, line 65Col. 8 line 5).

Griswold further disclose decrypting the information and validating this information to

allow access to the product after verifying the license has not expired (Col. 9 line 46-

Col. 10 line 36). It would have been obvious to one of ordinary skill in the art at the time

of applicant's invention to modify the method of Barber et al and encode any information

that corresponds to a license such as a version or model number of the product under

control of the license in lieu of a license identification information as taught by Griswold.

One would have been motivated to use any type of equivalent identifier in order to

effectively identify the license or the product being controlled by the license. Griswold

provides motivation by indicating that the types of information within the license

database may require other types than specifically shown (Col. 6 line 63-Cal. 7 line 3).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1, 4, 6-7, 10-11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Barber et al, U.S. Patent N. 5,390,297 in view of Griswold, U.S.

Patent No. 5,940,504 and Ross et al, U.S. Patent No. 5,553,143.

9.   As per Claim 1, Barber et al disclose a method for controlling access to a

product, the method comprising:

- receiving a license string that controls access to the product, the license string being

generated using a cryptographic process by encoding information corresponding to a

license identifier information (Col. 6, lines 43-60; Col. 9 line 67-Col. 10 line 7);

- verifying the license string by decoding the license string to identify the information

(Col. 10, lines 1-8) and determining that the information is within a valid range (Col. 10,

lines 1-15); and

- allowing access to the product based on verifying the license string (Col. 10, lines 1-

27).

10.   Barber et al, however, fails to explicitly disclose wherein the encoded information

corresponds to at least one of 1) a date of creation of the product, 2) a version of the

product, 3) a date of request for the product, and 4) a date of generation of the license

string. Griswold discloses a licensing management system and further teach sending

datagrams to a licensor's site to request authorization for access to a product wherein

the datagram includes encrypted information corresponding to a version of the product

such as a product model number (Figures 2 and 4; Col. 5, lines 45-50; Col. 6, lines 44-

48; Col. 7, line 65Col. 8 line 5). Griswold further disclose decrypting the information and

validating this information to allow access to the product after verifying the license has

not expired (Col. 9 line 46-Col. 10 line 36). It would have been obvious to one of

ordinary skill in the art at the time of applicant's invention to modify the method of

Barber et al and encode any information that corresponds to a license such as a version

or model number of the product under control of the license in lieu of a license

identification information as taught by Griswold. One would have been motivated to use

any type of equivalent identifier in order to effectively identify the license or the product

being controlled by the license. Griswold provides motivation by indicating that the types

of information within the license database may require other types than specifically

shown (Col. 6 line 63-Cal. 7 line 3).

11.   Barber et al further-fail to disclose wherein the data encoded to generate the

license string comprises a license data and a validation data and verifying the license

string further includes (i) decoding the license string to obtain the license data and the

validation data, (ii) computing a generated validation data based at least in part on at

least a portion of the decoded license data, and (iii) comparing the decoded validation

data with the generated validation data. Ross et al disclose a method for electronic

licensing and teach a method of validating a license by decoding the license string to

obtain the license data and the validation data (Col. 9, lines 1-11; Col. 7, lines 40-65;

decrypting the signature to obtain the clear text (license data) and the validation data

(message digest)), computing a generated validation data based at least in part on at

least a portion of the decoded license data (Col. 9, lines 1-11; Col. 7, lines 40-65;

applying the clear text to an algorithm to generate the message digest) and comparing

the decoded validation data with the generated validation data (Col. 9, lines 1-11; Col.

7, lines 40-65; comparing the two message digests). Accordingly, it would have been

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the

method of Barber et al and include the ability to validate the license as taught by Ross

et al in an effort to ensure that the license is valid and has not been altered or tampered

with in any way. Using digital signatures and hashing algorithms to generate message

digests has long been known in the encryption art as an effective method for validating a message or any type of text or data.

12.   As per Claims 4 and 6-7, Barber et al and Griswold do not specifically disclose that the encoding method includes using block ciphers or character text strings. Examiner takes Official Notice that these encoding methods are well known in the cryptography arts and it would have been obvious to one having ordinary skill in the art to use block ciphers and character text strings in order to take advantage of well known encoding methods as a matter, of convenience. With respect to claim 7, It is well known in the computer arts to "keep it simple" with respect to user interaction with computer programs. The capital letters 0 and I are easily confused with the numbers 0 and 1 which add to the complexity of reading what may be a long string of characters.

13.   Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to exclude the characters capital 0, capital I, and the numbers 0 and 1 from the License string generated by the invention of Barber et al ('297) in order to minimize user confusion in the entry of the license string.

14.   As per Claim 10, Barber et al ('297) further discloses the license string controls access to a single facility, see Column 8, lines 40-41.

15.   As per Claim 11, Barber et al ('297) further discloses the license string controls access to multiple facilities, see Column 8, lines 20-48.

16.   Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al, U.S. Patent No. 5,390,297, Griswold, U.S. Patent No. 5,940,504 and Ross

et al, U.S. Patent No. 5,553,143 as applied to claim 1 above, and further in view of

Smartsoft (Product Sales and Upgrade Sales).

17.   As per Claims 2-3, Barber et al further disclose that the customer supplies

encrypted license string information, however, fails to specifically disclose that this is

provided using a dialog box or entry field. Smartsoft discloses using a dialog box or

entry field to provide the license string (Page 4). It would have been obvious to one of

ordinary skill in the art at the time of applicant's invention to modify the method of

Barber et al and provide this license string any number of ways including using a dialog

box or entry field as taught by Smartsoft in an effort to provide convenience and

flexibility to the end user by using a web based system.

18.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et

al, U.S. Patent No. 5,390,297, Griswold, U.S. Patent No. 5,940,504 and Ross et al, U.S.

Patent No. 5,553,143 as applied to claim 1 above, and further in view of He et al, U.S.

Patent No. 6,088,451.

19.   As per Claim 9, Barber et al ('297) does not specifically disclose wherein the

license string includes a first checksum and verifying the license string comprises

generating a second checksum based on the information and comparing the second

checksum with the first checksum.

20.   He et al (451) teaches the use of a checksum, a well known method for data

string validation, see Column 10, lines 18-47, for the benefit of protecting information

from being accidentally or maliciously changed and ensuring correct communication

between user and the network. Therefore, it would have been obvious to one of ordinary

skill at the time the invention was made to include the checksum validation taught by He

et al ('451) in the invention of Barber et al ('279) for the benefit of protecting information

from being accidentally or maliciously changed and ensuring correct communication

between user and the network.

21.   Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Barber et al, U.S. Patent No. 5,390,297, Griswold, U.S. Patent No. 5,940,504 and Ross

et al, U.S. Patent No. 5,553,143 as applied to claim 1 above, and further in view of

Edwards Jr, U.S. Patent No. 5,014,234.

22.   As per Claim 13, Barber et al ('297) does not specifically disclose wherein access

to the product is allowed for only a predetermined period of time in the absence of

verifying the license string. Edwards Jr ('234) teaches limited usage for predetermined

period of time before the license string is entered, see Column 1, line 25 - Column 2,

line 3 for the benefit of providing a "try before you buy" license feature and still allow

protection of the software.

23.   Therefore, it would have been obvious to one of ordinary skill at the time the

invention was made to modify the invention of Barber et al ('297) to allow usage for a

predetermined period of time before the license string is entered providing a "try before

you buy" license feature and still allow protection of the software.

24.   As per Claim 14, Barber et al ('297) does not specifically disclose entry of the

license string extends the predetermined time for which the product will function.

Edwards Jr ('234) teaches entry of the defuse number extends the usage for

predetermined period of time, see Column 8, lines 16 - 39 for the benefit of allowing

continued use of the product and still allow protection of the software. Therefore, it

would have been obvious to one of ordinary skill at the time the invention was made

to modify the invention of Barber et al ('297) to allow usage for a predetermined period

of time after the license string is entered for the benefit of allowing continued use of the

product and still allow protection of the software.

25.   Examiner's Note 1: Examiner has cited particular columns and line numbers in

the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested that the applicant, in preparing the

responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the examiner.

26.   Examiner's Note 2: Examiner would also like to point out that Official Notice was

used in previous office actions to indicate that it is old and well known in the art to use

encoding methods such as block ciphers or character text strings. Examiner also

indicated that it is well known in the computer arts to 'keep it simple' with respect to user

interaction with computer programs. The capital letters O and I are easily confused with

the numbers 0 and 1 which add to the complexity of reading what may be a long string

of characters. Since applicant has not attempted to traverse this Official Notice

statement, examiner is taking the common knowledge or well-known statement to be

admitted prior art.

Conclusion

27.   The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

28.   Hasebe et al disclose a software license protection method using cryptography wherein a request is for authorized use of the software is encrypted and subsequently validated by an accounting server.

29.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30.   A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

32.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on 571-272-6712. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

33.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER
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